

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 09/759,993

Confirmation No.: 1053

Filed: 12 January 2001

For: ADHESIVE FILM REMOVAL METHOD AND APPARATUS

Remarks

The Final Office Action dated 2 January 2003 has been received and reviewed. Claims 6, 7, 19, and 20 having been canceled, and claims 26-43 having been presented, the pending claims are claims 1, 4, 5, 8-13, 17-18, and 21-47. Reconsideration and withdrawal of the rejections are respectfully requested.

Applicants have noted a discrepancy in the Office Action mailed 2 January 2003. The Office Action Summary indicates that claims 6, 7, 10 and 19 are objected to. The Detailed Action indicates, however, that "Claims 6-7 and 19-20 are objected to" (Allowable Subject Matter, ¶ 6, p. 4). For purposes of this response, Applicants have assumed that claims 6-7 and 19-20 should have been indicated as allowable in the Office Action Summary.

Corrected Drawings

Applicants note approval of the proposed drawing corrections previously submitted. Applicants are concurrently filing a set of corrected formal drawings via Express Mail incorporating the approved corrections.

Allowable Subject Matter

As discussed above, claims 6, 7, 19 and 20 were indicated as allowable if rewritten to include their respective base and any intervening claims. Applicants have canceled claims 6, 7, 19, and 20 and rewritten them as independent claims 26, 31, 36 and 40 (respectively). In addition, dependent claims for each of these independent claims have also been presented to provide more comprehensive protection of the claimed inventions.

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The 35 U.S.C. §102 Rejections

Claims 1, 4, 8-13, 17, 21-22 and 25 were rejected under 35 U.S.C. §102(b) as being anticipated by French Patent Publication 2643487 to Apollonio et al. (hereinafter "Apollonio"). Applicants respectfully traverse this rejection as follows.

Applicants traverse the assertion that Apollonio teaches "transferring the tension onto the substrate through a compressive roller" as set forth in the Office Action. There is no discussion in Apollonio regarding the transfer of tension forces to compression onto the substrate. Furthermore, Applicants submit that no such transfer of tension to compression could occur in the Apollonio device. The structure of the Apollonio device includes a rigid pole (1), which provides the track for the carriage (3) containing the first spool (24), used to collect the poster strip being removed, and third spool (22), used to hold the poster strip being hung. The carriage moves up and down the track (rigid pole 1) to collect and hang successive poster strips. This pole is attached to a gantry or cross-piece (15). Given this structure, Applicants submit that tension forces generated during film removal would be directed onto rigid pole (1) through carriage (3).

It is, however, asserted in the Office Action that "[i]t is the examiner's contention that the basic structures of both Apollonio et al. and Kuroda et al. are equivalent to the structure of the instant invention. For this reason, the properties of physics in Apollonio et al. and Kuroda et al. would parallel the properties of physics in the instant invention which transfers the tension back onto the substrate." Office Action, p. 4, Para. 7. Applicants traverse these assertions.

Essentially, the Office Action asserts that the structure of Apollonio "inherently" discloses the inventions recited in independent claims 1, 12, and 22. But Applicants submit that the standards for establishing "inherency" with respect to anticipation have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112, p. 2100-52, 8th Ed., Rev. 1, (Feb. 2003) (emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* (emphasis in original).

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As discussed in the present response and previous responses, the apparatus disclosed by Apollonio operates or is constructed such that any tension force developed during removal of a film is transferred to pole (1), not back to the surface of the substrate as a compressive force. The Office Actions have not presented any basis in fact or technical reasoning to the contrary beyond conclusory statements that the structures are "equivalent" and that the "properties of physics" in the present invention "parallel" those of Apollonio. As a result, Applicants submit that the Office has not met its burden in establishing "inherency" of the claimed subject matter in Apollonio.

Furthermore, Applicants submit that the respective dependent claims of each of independent claims 1, 12, and 22 that are subject to this rejection each recite additional subject matter that provides additional bases for patentability of the claimed inventions.

For the above reasons, Applicants submit that the rejection of claims 1, 4, 8-13, 17, 21-22 and 25 under § 102 is not supported by Apollonio. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

Claims 1, 5, 8-10, 12, 18, 21-22, and 25 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,891,298 to Kuroda et al. (hereinafter "Kuroda"). Applicants respectfully traverse the rejection as follows.

In support of the rejection it is asserted that take up roll 18 of Kuroda transfers the tension onto the substrate through compressive roller 8. Applicants first note that the description of the disclosure of Kuroda as presented in the Office Action is unclear. For example, the Office Action refers to "take up roll, 18," in connection with FIG. 8. No such roll is described in Kuroda. And although a "tape supply roll 18" is described in Kuroda, it is described in connection with FIGS. 12 & 13, not FIG. 8.

The Office Action also asserts that Kuroda teaches "transferring the tension onto the substrate through a compressive roller." There is, however, no discussion in Kuroda regarding the transfer of tension onto the substrate in the form of a compressive force. Furthermore, as

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discussed in the previous response and herein, the structure of Kuroda indicates that such a transfer of tension does not occur.

Support for the above assertion is apparently based on "the examiner's contention that the basic structures of both Apollonio et al. and Kuroda et al. are equivalent to the structure of the instant invention. For this reason, the properties of physics in Apollonio et al. and Kuroda et al. would parallel the properties of physics in the instant invention which transfers the tension back onto the substrate." Office Action, p. 4, ¶ 7. Applicants traverse these assertions.

Essentially, the Office Action asserts that the structure of Kuroda "inherently" discloses the inventions recited in independent claims 1, 12, and 22. But Applicants submit that the standards for establishing "inherency" with respect to anticipation have not been met. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112, p. 2100-52, 8th Ed., Rev. 1, (Feb. 2003) (emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* (emphasis in original).

As discussed in the present response and previous responses, there is no teaching that the apparatus disclosed by Kuroda operates or is constructed such that any tension force developed during removal of the peeling tape is transferred back to the surface of the substrate as a compressive force through roller 8. Any tension forces could, for example, be directed to the framework supporting the various rollers (*see, e.g.*, Kuroda, FIGS. 13 & 24) without ever being transferred back to the substrate as asserted in the Office Action.

Furthermore, the Office Action does not present any basis in fact or technical reasoning supporting its assertions beyond conclusory statements that the structures are "equivalent" and that the "properties of physics" in the present invention "parallel" those of Kuroda. As a result, Applicants submit that the Office has not met its burden in establishing "inherency" of the claimed subject matter in Kuroda.

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Applicants also submit that the respective dependent claims of each of independent claims 1, 12, and 22 that are subject to this rejection each recite additional subject matter that provides additional bases for patentability of the claimed inventions.

For the above reasons, Applicants submit that the rejection of claims 1, 5, 8-10, 12, 18, 21-22 and 25 under § 102 is not supported by Kuroda. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The 35 U.S.C. §103 Rejection

Claims 23 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over French Patent Publication 2643487 to Apollonio et al. (hereinafter "Apollonio"). Applicants respectfully traverse the rejections.

Applicants respectfully submit that Apollonio fails to support a proper *prima facie* case of obviousness. For example, Applicants respectfully submit that Apollonio fails to teach all of the limitations of independent claim 22 (from which claims 23 and 24 depend) as discussed above with respect to the rejection under § 102. Applicants further submit that no suggestion or motivation has been identified that would lead one of ordinary skill in the art to modify the apparatus of Apollonio to reach the invention of claim 22.

With respect to the rejection of claims 23 and 24, Applicants submit that these claims recite additional features that further define the patentability of the invention recited in claim 22.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 23 and 24 as obvious in view of Apollonio.

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Summary

It is respectfully submitted that the pending claims 1, 4-5, 8-13, 17-18, and 21-43 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: Box AF, Washington, D.C. 20231, on this 27th day of March, 2003, at 12:56 p.m. (Central Time).

By: Rachel Gagliardi-Gebhardt
Name: Rachel Gagliardi-Gebhardt

**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS
INCLUDING NOTATIONS TO INDICATE CHANGES MADE**

Serial No.: 09/759,993

Docket No.: 56077US002 (formerly 56077USA7A.002)

Amendments to the pre-existing claims are indicated by underlining what has been added and bracketing what has been deleted. Additionally, all amendments and new claims are presented in bold typeface.

1. A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:
applying tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;
transferring the tension onto the substrate in the form of a compressive force, wherein the compressive force is applied to the substrate at a distance from the release line; and
advancing the release line and the compressive force towards the second end of the adhesive film, whereby the adhesive film is removed from the substrate.
4. A method according to claim 1, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.
5. A method according to claim 1, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.
8. A method according to claim 1, wherein the compressive force is applied to the substrate by a roll.
9. A method according to claim 1, wherein applying tension over the width of the adhesive film comprises attaching the first end of the adhesive film to a winding roll and winding the adhesive film thereon.

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10. A method according to claim 9, wherein the compressive force is applied to the substrate by a support roll, and further wherein the winding roll and the support roll are located a fixed distance apart.

11. A method according to claim 1, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.

12. A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:

attaching the first end of the adhesive film to a winding device;

rotating the winding device to apply tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;

transferring the tension applied to the adhesive film onto the substrate in the form of a compressive force, with the compressive force being applied to the substrate by the winding device and wherein the compressive force is applied to the substrate at a distance from the release line; and

advancing the release line towards the second end of the adhesive film while winding the adhesive film on the winding device, whereby the adhesive film is removed from the substrate.

13. A method according to claim 12, wherein the adhesive film comprises a large-scale adhesive film.

17. A method according to claim 12, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.

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18. A method according to claim 12, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.
21. A method according to claim 12, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.
22. An apparatus for removing adhesive film from a substrate, the apparatus comprising:
a winding roll attached to a frame, the winding roll comprising a longitudinal axis;
a motor operably connected to the winding roll for rotating the winding roll about its longitudinal axis; and
a support roll rotatably attached to the frame, the support roll located a fixed distance from the winding roll, wherein the winding roll and the support roll are arranged on the frame such that tension applied to an adhesive film during removal of the adhesive film from the substrate is transferred to the substrate as compression through the support roll, and wherein the support roll is not located at a release line of the adhesive film.
23. The apparatus of claim 22, wherein the support roll comprises an outer conformable surface.
24. The apparatus of claim 22, wherein the motor comprises a variable speed motor.
25. The apparatus of claim 22, further comprising a heating device.
26. (NEW) A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:

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applying tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;

transferring the tension onto the substrate in the form of a compressive force, wherein the compressive force is applied to the substrate at a distance from the release line; varying the distance between the compressive force and the release line; and advancing the release line and the compressive force towards the second end of the adhesive film, whereby the adhesive film is removed from the substrate.

27. (NEW) A method according to claim 26, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.

28. (NEW) A method according to claim 26, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.

29. (NEW) A method according to claim 26, wherein applying tension over the width of the adhesive film comprises attaching the adhesive film to a winding roll and winding the adhesive film thereon, and further wherein the compressive force is applied to the substrate by a support roll, and further wherein the winding roll and the support roll are located a fixed distance apart.

30. (NEW) A method according to claim 26, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.

31. (NEW) A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:

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applying tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;
transferring the tension onto the substrate in the form of a compressive force, wherein the compressive force is applied to the substrate at a distance from the release line;
varying the distance between the compressive force and the release line by varying the tension applied to the adhesive film; and
advancing the release line and the compressive force towards the second end of the adhesive film, whereby the adhesive film is removed from the substrate.

32. (NEW) A method according to claim 31, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.

33. (NEW) A method according to claim 31, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.

34. (NEW) A method according to claim 31, wherein applying tension over the width of the adhesive film comprises attaching the adhesive film to a winding roll and winding the adhesive film thereon, and further wherein the compressive force is applied to the substrate by a support roll, and further wherein the winding roll and the support roll are located a fixed distance apart.

35. (NEW) A method according to claim 31, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.

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36. (NEW) A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:

- attaching the first end of the adhesive film to a winding device;
- rotating the winding device to apply tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;
- transferring the tension applied to the adhesive film onto the substrate in the form of a compressive force, with the compressive force being applied to the substrate by the winding device and wherein the compressive force is applied to the substrate at a distance from the release line;
- varying the distance between the compressive force and the release line; and
- advancing the release line towards the second end of the adhesive film while winding the adhesive film on the winding device, whereby the adhesive film is removed from the substrate.

37. (NEW) A method according to claim 36, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.

38. (NEW) A method according to claim 36, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.

39. (NEW) A method according to claim 36, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.

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40. (NEW) A method of removing adhesive film from a substrate, the adhesive film comprising first and second ends defining a length and a width transverse to the length, the method comprising:

attaching the first end of the adhesive film to a winding device;

rotating the winding device to apply tension over the width of the adhesive film to remove the adhesive film from the substrate along a release line;

transferring the tension applied to the adhesive film onto the substrate in the form of a compressive force, with the compressive force being applied to the substrate by the winding device and wherein the compressive force is applied to the substrate at a distance from the release line;

varying the distance between the compressive force and the release line by varying the speed at which the winding device is rotated; and

advancing the release line towards the second end of the adhesive film while winding the adhesive film on the winding device, whereby the adhesive film is removed from the substrate.

41. (NEW) A method according to claim 40, wherein the compressive force is applied to the substrate behind the release line as the release line advances toward the second end of the adhesive film.

42. (NEW) A method according to claim 40, wherein the compressive force is applied to the substrate ahead of the release line as the release line advances toward the second end of the adhesive film.

43. (NEW) A method according to claim 40, further comprising heating the adhesive film before removing the adhesive film from the substrate along the release line.

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: BOX AF, Washington, D.C. 20231, on this 27th day of March, 2003, at _____ (Central Time).

By: _____
Name: _____